

REMARKS

This responds to the Office Action dated October 27, 2006.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-10, 12-28, and 29-35 are now pending in this application.

Information Disclosure Statement

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form on August 11, 2006. Applicant respectfully requests that initialed copies of the 1449 forms be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

§102 Rejection of the Claims

Claims 1-10, 12-28 and 31-35 were rejected under 35 U.S.C. § 102(e) for anticipation by Grainger et al. (U.S. Patent Application Publication No. 2002/0065677 A1).

The final Office Action restates the rejection of claims 1-10, 12-28 and 31-35 under 35 U.S.C. § 102(e) and the arguments made in the Office Action dated April 13, 2006, but does not express any opinions or comments on Applicant's response to the Office Action dated April 13, 2006.

Applicant respectfully traverses the rejection of claims 1-10, 12-28 and 31-35 under 35 U.S.C. § 102(e) for the reasons stated as follows.

Regarding claim 1:

Applicant reproduces independent claim 1 below:

“1. A system for managing information disclosure statement (IDS) references, comprising: a computing system;

a first software component operable on the computing system to generate a plurality of IDS forms; and

a second software component operable on the computing system to manage IDS references for at least one organization;

wherein each organization only has access to its own IDS references.”

The Office Action indicates that Grainger teaches such a feature of claim 1, “each organization only has access to its own IDS references.” Applicant disagrees. Applicant submits that Grainger does not teach the feature “each organization only has access to its own IDS references” as positively recited in claim 1 of the application.

Referring to paragraph 0080 of the Grainger publication relied upon by the Office Action, Grainger states, “Additionally, each client system would be able to access all of the electronic IDS stored in database 804. This embodiment is particularly suited for applications where multiple users will be generating and accessing the same electronic IDS for a single pending or future patent application.” Further referring to paragraph 0081 of the Grainger publication relied upon by the Office Action, **“the access to each electric IDS may be limited to individuals falling under the duty of disclosure for the corresponding future or pending patent application.”**

Thus, according to Grainger, it can be seen that individuals may have access to IDS references which are not their own, as long as the individuals are falling under the duty of disclosure for the corresponding future or pending patent application. Therefore, clearly, Grainger teaches away from the feature **“each organization only has access to its own IDS references”** which is positively recited in claim 1.

Furthermore, the Office Action fails to mention whether/where Grainger teaches or suggests “a second software component operable on the computing system to manage IDS references for at least one organization.” In fact, Grainger does not teach or suggest **“a second software component operable on the computing system to manage IDS references for at least one organization”** as recited in claim 1.

Therefore, Applicant submits Grainger cannot be said to anticipate claim 1 of the application and respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(e) be withdrawn.

Regarding claim 2:

Claim 2 depends on claim 1. For at least the same reasons discussed for claim 1, Applicant submits that Grainger cannot be said to anticipate claim 2.

Additionally, the system of claim 2 further comprises **“third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization.”** However, Figs. 13A-20 of Grainger, relied upon by the Office Action, does not indicate the existence of the third software component **“for managing the IDS references associated with each matter of the at least one organization.”** Thus, Applicant submits that claim 2 cannot be said to be anticipated by Grainger.

Regarding claim 3:

Claim 3 depends on claim 2. For at least the same reasons discussed for claim 2, Applicant submits that Grainger cannot be said to anticipate claim 3.

Claim 3 further comprises: **“a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component.”**

The Office Action implies that Fig. 13A shows “Prior Art associated with Case”. However, the feature “Prior Art associated with Case” of Grainger teaches away from the feature of claim 3, since Grainger manages all the prior arts which are associated with each particular case, while the system of claim 3 manages all the cases (matters) for each particular organization. Thus, Grainger teaches away from claim 3. Additionally, Grainger does not mention **“the second software component is a part of the fourth software component”** as recited in claim 3. Thus, Applicant submits that claim 3 cannot be said to be anticipated by Grainger.

Regarding claim 4:

Claim 4 depends on claim 3. Furthermore, claim 4 positively discloses that the system further comprises:

“a fifth software component operable on the computing system to manage activities within matters;

a sixth software component operable on the computing system to manage organizations;

a seventh software component operable on the computing system to manage tasks within matters;

an eighth software component operable on the computing system to provide communications; and

a ninth software component operable on the computing system to provide security;

wherein the third, fourth, fifth, sixth, seventh, eighth, and ninth software components are capable of interfacing with the first and second software components in a patent prosecution enterprise application.”

However, the Office Action fails to point out which parts of Figs. 13A-20 of Grainger show correspondingly the existence of fifth, sixth, seventh, eighth, and ninth software components for performing the relevant operations. Thus, for this reason and reason discussed for claim 3, Applicant submits that claim 4 is not anticipated by Grainger.

Regarding claim 5:

Claim 5 depends on claim 1. Furthermore, claim 5 positively discloses that the system further comprises: “an IDS holder; an IDS patents holder related to the IDS holder; an IDS publications holder related to an IDS table; and an IDS source holder to indicate how to access the stream of data associated with each IDS reference.”

However, Figs. 13A-20 of Grainger, relied upon by the Office Action, does not correspondingly indicate the existence of IDS holder, IDS patents, IDS publications holder, and IDS source holder. Thus, for this reason and reason discussed for claim 1, Applicant submits that claim 5 is not anticipated by Grainger.

Regarding claims 6-9:

Claims 6-9, depend directly or indirectly on claim 5, accordingly, for at least the same reasons discussed for claim 5, Applicant submits that claims 6-9 are not anticipated by Grainger.

Regarding claim 10:

Claim 10 claims:

“A method for IDS reporting, comprising:

receiving a report specification;

interpreting the report specification;

generating an answer file;

receiving a plurality of transformations to act on the answer file and an IDS form definition file; and

providing an IDS report.”

Grainger mentions extracting IDS information from electronic documents into IDS in paragraphs 0038-0039. However, Grainger does not teach or suggest the steps “**generating an answer file**” and “**receiving a plurality of transformations to act on the answer file and an IDS form definition file**”, which are positively recited in claim 10. Thus, Applicant submits that claim 10 is not anticipated by Grainger.

Regarding claim 12:

Claim 12 depends on claim 10, accordingly, for at least the same reasons discussed for claim 10, Applicant submits that claim 12 is not anticipated by Grainger.

Regarding claim 13:

Claim 13 claims:

“A method for managing information disclosure statement (IDS) references, comprising:

receiving a request to add an new information disclosure statement (IDS) reference to a first matter;

searching for all matters related to the first matter; and

adding the new IDS reference to selected matters related to the first matter.”

The Office Action implies that Fig. 5 of Grainger discloses claim 13. Fig. 5 of Grainger is a flowchart illustrating the generation of an IDS. However, Fig. 5 of Grainger, relied upon by the Office Action does not teach or suggest the steps “**searching all matters related to the first matter**” and “**adding the new IDS reference to selected matters related to the first matter**” as positively recited in claim 13. In fact, Fig. 5 of Grainger does not teach or suggest adding Information Disclosure Statement(s) of a case to all the cases related to that case. Thus, Applicant submits that claim 13 is not anticipated by Grainger.

Regarding claim 14-16:

Claims 14-16, directly or indirectly, depend on claim 13, accordingly, for at least the same reasons discussed for claim 13, Applicant submits that claims 14-16 are not anticipated by Grainger.

Regarding claim 17:

Claim 17 claims:

“A system for managing information disclosure statement (IDS) references, comprising:
a computing system;
a presentation layer operable on the computing system to present an information disclosure statement (IDS) reference inventory system;
a business logic layer operable on the computing system to manage the IDS reference inventory system and to generate IDS forms; and
a data layer operable on the computing system to manage the data associated with the IDS reference inventory system.”

The Office Action implies that Fig. 11 of Grainger discloses claim 17. Fig. 5 of Grainger is a block diagram illustrating the relationship between an IP data processing system 1100 and participants in the patent process, like technology developers, patent law firms, patent offices, prior art databases, and potential licensees. However, FIG. 11 of Grainger does not include **the business logic layer** as recited in claim 17. Thus, Applicant submits Grainger cannot be said to anticipate claim 17.

Regarding claims 18-20:

Claims 18-20 depend on claim 17, accordingly, for the reasons discussed for claim 17, Applicant submits that claims 18-20 are not anticipated by Grainger.

Regarding claim 21:

Claim 21 claims:

“A computer-readable medium storing computer-executable instructions for performing a method, the method comprising:

providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter;

providing a presentation capable of listing each IDS reference associated with each matter; and

restricting access to IDS references so that each organization only has access to its own IDS references.”

However, Grainger does not teach or suggest the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” as positively recited in claim 21. Thus, Applicant submits Grainger cannot be said to anticipate claim 21.

Regarding claims 22-28 and 31-35:

Claims 22-28 and 31-35, directly or indirectly, depend on claim 21, accordingly, for at least the same reasons discussed for claim 21, Applicant submits that claims 22-28 and 31-35 are not anticipated by Grainger.

§103 Rejection of the Claims

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger et al. (U.S. Patent Application Publication No. 2002/0065677 A1) in view of Official Notice.

The final Office Action restates the rejection of claim 30 under 35 U.S.C. § 103(a) and the arguments made in the Office Action dated April 13, 2006, but does not express any opinions or comments on the Applicant's response to the Office Action dated April 13, 2006.

Applicant respectfully traverses the rejection of claim 30 under 35 U.S.C. § 103(a) for the reasons stated below.

According to M.P.E.P. 2144.03 A. “**Official notice** without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.”

The Applicant respectfully requests of the examiner the documentary evidence to support the examiner's conclusion.

Furthermore, to retain a rejection to a claim under §103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Office Action acknowledges that Grainger fails to teach “providing an accounting system to track costs associated with storing IDS references” which is recited in claim 30.

Claim 30 depends on claim 21. Accordingly, claim 30 includes the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” of claim 21. However, Applicant submits that this feature is not disclosed in Grainger.

See paragraph 0080 of the Grainger publication, which states the following: “Additionally, each client system would be able to access all of the electronic IDS stored in database 804. This embodiment is particularly suited for applications where multiple users will be generating and accessing the same electronic IDS for a single pending or future patent application.” And see paragraph 0081, “the access to each electric IDS may be limited to

individuals falling under the duty of disclosure for the corresponding future or pending patent application.” Thus, according to Grainger, it can be seen that individuals may have access to IDS references which are not their own, as long as they are falling under the duty of disclosure for the corresponding future or pending patent application. Therefore, clearly, Grainger teaches away from the feature “**each organization only has access to its own IDS references**” which is included in claim 30.

Thus, Grainger does not teach or suggest all the limitations which are recited in claim 30, and certainly does not suggest to combine reference teachings. Accordingly, Applicant submits that claim 30 is not rendered obvious over Grainger in view of Official Notice, and respectfully request that the rejection of claim 30 under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

Applicant respectfully submits that claims 1-10, 12-28, and 29-35 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6966 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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Date March 20, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22318-1450, on this 20 day of ~~June~~ March, 2007.

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Signature

